

REMARKS

Claims 1-3 and 5-34 were examined. Upon entry of the present amendment, claims 26-32 are amended to correct informalities in the claims. Applicants hereby request further examination and reconsideration of the application in view of the following remarks.

Claims 26-31 were objected to because of informalities. Claims 26-31 have been amended as requested to correct the informalities in the claims. Claim 32 has also been amended to correct an informality noted by the Applicant.

Claims 11-27 and 30-31 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner argues that the specification does not disclose that the first and second remote units exchange the synchronized message via the assigned channel. The Examiner further asserts that the remote units are synchronized by the central unit. Applicant respectfully disagrees and traverses this rejection for at least the following reasons

Claim 11, as amended, recites "the second remote unit synchronizing to said first remote unit during communication with said first remote unit via the dedicated radio frequency connection," while claim 20, as amended, recites "synchronizing the second remote unit to the first remote unit during direct communication between the first remote unit and the second remote unit via the dedicated communication channel." Thus, claims 11 and 20 claim that *during direct communication between the first remote unit and the second remote unit via the dedicated communication channel*, the second remote unit synchronizes to the first remote unit. This aspect of the invention is clearly described on page 6, line 25 through page 7, line 13, of Applicant's specification, which provides

As shown in FIG. 2, once the central unit 12 initiates the dedicated wireless connection or channel "F" between the first remote unit 14 and the second remote unit 16, the remote units 14 & 16 may then be allowed to communicate directly, i.e., the information communicated is not communicated through the central unit 12. The first or "requesting" unit 14 functions as a "temporary central unit" wherein the second remote unit 16 synchronizes to the first unit 14. Thus, in an embodiment of the communication system 10 wherein the first and second remote units 14 & 16

are comprised respectively of a personal computer and printer each having a cordless data adapter providing access to the wireless network 24, a print job communicated from the personal computer to the printer would be communicated directly with the printer without first going through the central unit 12.

When communication between the first and second remote units 14 & 16 ceases, the first remote unit 14, or alternately, the second remote unit 16, may provide an indication to the central unit 12 that direct communication between the remote units 14 & 16 has ended. The direct communication channel "1" between the first remote unit 14 and the second remote unit 16 may then be terminated, and its assigned hop sequence, or, alternately, spreading code made available for use by another connection within the wireless network 24. The first remote unit 14 and second remote unit 16 may then return to their original state and again synchronize to the central unit 12 as shown in FIG. 1.

Consequently, no new matter was added by the amendments to claims 11 and 20 presented in the Response to the Office Action of June 17, 2004. Withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is therefore requested.

Claims 1-3, 6-10 and 28-29 are rejected under 35 U.S.C. § 102(b) as being anticipated by Miyake et al., U.S. Patent No. 5,903,618 (Miyake). Applicant traverses the rejection of these claims for at least the following reasons.

Miyake fails to disclose, teach or suggest a second remote unit that synchronizes to the first remote unit during direct communication with the first remote unit via the dedicated radio frequency connection. Instead, Miyake specifically discloses that

All the terminals included in the service area of the base station are *always* synchronized with sync signals paged from the base station.

Miyake, Abstract (emphasis added). Thus, as previously noted by Applicant, *all* terminals of the Miyake system *always* synchronize to the base station via sync signals paged from the base station, even during direct communication between the terminals. Consequently, substituting the lexicography of the present application, Miyake discloses

only that during direct communication between a first remote unit and a second remote unit, the first and second remote units would *continue* to synchronize with the central unit, and as a consequence would remain in sync with each other. Nowhere does Miyake disclose that the second remote unit would directly synchronize to the first unit *instead* of the central unit as claimed, thus allowing the central unit to hand off synchronization of the first and second units to the first unit during direct communication between the first and second remote units. As a result, Miyake fails to anticipate the cordless communication system presently recited in independent claim 1 along with its respective dependent claims 2-3, 6-10 and 28-29. Claims 1-3, 6-10 and 28-29 are therefore believed to be patentable over the Miyake reference for at least the above reasons, and withdrawal of the rejection under 35 U.S.C. § 102(b) is requested.

Claims 11-27 and 30-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyake in view of Morvan et al., U.S. Patent No. 6,574,452 (Morvan). Applicant traverses the rejection of these claims for at least the following reasons.

M.P.E.P. 2131.02 provides that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. M.P.E.P. 2131.02, *citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In the Miyake system the base station controls all communication within the system. Specifically, as noted above, Miyake teaches that

All the terminals included in the service area of the base station are *always* synchronized with sync signals paged from the base station.

Miyake, Abstract (emphasis added). Thus, *all* terminals of the system *always* synchronize to the base station via sync signals paged from the base station.

In the system taught by Morvan, on the other hand, the communication devices themselves, not the base station, control communication within the system. For direct communication to be established between communication devices is established, Morvan requires that

the communication device 4102 sends a message 4503 which passes, transparently, through the base station 4101, in order to reach the communication device 4103. . . .

When the connection with the communication device 4103, through the base station 4101, is closed, the communication device 4102 automatically switches into base station operating mode. The communication device 4102 is then referred to as the "new base station". Next, the communication device 4103 starts a procedure for synchronising itself with the new base station 4102, after having performed a detachment procedure with the base station 4101. When the communication device 4103 is synchronised with the communication device 4102, the communication device 4103 uses the procedure defined by the DECT standard for establishing a connection in encrypted mode (exchange of messages 4507 and 4508), in order to exchange confidential data between the communication devices 4102 and 4103.

Morvan, column 41, lines 16-39.

In order for the terminals taught by Miyake to synchronize to one another in the manner taught by Morvan, the terminals and not the base station of the Miyake system would be required to control all communication within the system including synchronization, significantly altering a primary principle of operation of the Miyake system, i.e., that the terminals always synchronize to the base station. Consequently, in accordance with M.P.E.P. 2131.02, the teachings of the Miyake and Morvan references cannot be combined in the manner suggested by the Examiner, and are not sufficient in and of themselves to render claims 11-27 and 30-34 *prima facie* obvious. Withdrawal of the rejection of claims 11-27 and 30-34 under 35 U.S.C. § 103(a) is therefore respectfully requested.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance.
For at least the foregoing reasons, Applicants respectfully request reconsideration and full allowance of all pending claims.

Date: March 14, 2005

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